

ESTTA Tracking number: **ESTTA131189**

Filing date: **03/21/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	Opus Corporation
Granted to Date of previous extension	03/21/2007
Address	10350 Bren Road West Minnetonka, MN 55343 UNITED STATES

Name	Opus Northwest Construction Corporation
Granted to Date of previous extension	03/21/2007
Address	10350 Bren Road West Minnetonka, MN 55343 UNITED STATES

Name	Opus Architects & Engineers, Inc.
Granted to Date of previous extension	03/21/2007
Address	10350 Bren Road West Minnetonka, MN 55343 UNITED STATES

Attorney information	Michael M. Lafeber Briggs and Morgan, P.A. 2200 IDS Center, 80 South Eighth Street Minneapolis, MN 55402 UNITED STATES mlafeber@briggs.com Phone:612-977-8472
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Applicant Information

Application No	78858928	Publication date	11/21/2006
Opposition Filing Date	03/21/2007	Opposition Period Ends	03/21/2007
Applicant	Terra Opus, LLC P.O. Box 500395 Atlanta, GA 31159 UNITED STATES		

Goods/Services Affected by Opposition

Class 019.

All goods and services in the class are opposed, namely: Decorative interior ceramic, glass and stone tile

Related
Proceedings

Application Serial No. 78858953

Attachments

Notice of Opposition 78858928.pdf (5 pages)(128915 bytes)

Signature

/Michael M. Lafeber/

Name

Michael M. Lafeber

Date

03/21/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No.	:	78858928
For the Mark For the Mark	:	TERRA OPUS
Filed	:	April 11, 2006
Published in the Trademark Official Gazette on	:	November 21, 2006

Opus Corporation, Opus Northwest Construction
Corporation, and Opus Architects & Engineers,
Inc.,

Opposers,

v.

Terra Opus, LLC,

Applicant.

Commissioner of Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

OPPOSERS' NOTICE OF OPPOSITION

Opus Corporation ("Opus"), Opus Northwest Construction Corporation ("Opus Northwest"), and Opus Architects & Engineers, Inc. ("Opus A&E") and their affiliates (collectively, "Opposers") believe, in good faith, that they will be damaged by registration of the mark shown in the above-identified application ("Application"), and hereby oppose the registration.

Opposers' grounds for opposition are as follows:

1. Opus is a Minnesota corporation with its principal place of business at 10350 Bren Road West, Minnetonka, Minnesota 55343. Opus Northwest is a Minnesota corporation and wholly owned subsidiary of Opus, with its principal place of business at 10350 Bren Road West, Minnetonka, Minnesota 55343. Opus A&E is a Minnesota corporation with its principal place of business at 10350 Bren Road West, Minnetonka, Minnesota 55343.

2. Pursuant to 15 U.S.C. § 1055, the use of the OPUS Marks by any and all related companies inures to the benefit of the registrant, Opus Northwest.

3. Opus Northwest owns the federally registered mark OPUS, Registration No. 1,262,651, dated December 27, 1983 (the "OPUS Word Mark"), registered in connection with leasing, purchasing, selling and managing land and buildings for others; construction services, namely, constructing commercial, residential, governmental, and industrial buildings for others; and architectural, engineering and design services (in international classes 36, 37 and 42, respectively). Opus first used the OPUS Word Mark in 1975 and has used it continuously since then.

4. Opus Northwest owns the federally registered mark OPUS plus hexagonal design (the "OPUS Design Mark"), Registration No. 2,520,075, dated December 18, 2001, registered in connection with managing and leasing real property, namely, land and commercial, industrial and professional complexes to and for others; real estate investment; real estate brokerage; construction services in the field of building commercial, industrial and professional complexes for others; real estate development; and architectural and engineering consulting services, namely, designing land developments and building improvements including commercial, industrial and professional complexes (in international classes 36, 37 and 42, respectively). Opus first used the OPUS Design Mark in 1989 and has used it continuously since then.

5. Opus Northwest licenses the OPUS Word Mark and the OPUS Design Mark (collectively, the "Registered OPUS Marks") to Opus, and Opus A&E and other affiliates of Opus Northwest for use throughout the United States.

6. Opposers sell a full range of integrated services across the United States under the Registered OPUS Marks, including real estate development, architecture and engineering, construction, property management, financing, leasing and sales services. Its construction projects include industrial, institutional, office, retail and residential developments. Opposers' goods and/or services include without limitation the design of interior and exterior spaces and the selection and installation of appropriate construction materials therefor including, but not limited to, ceramic, glass and stone tile.

7. Opposers have used the trade name "OPUS" since approximately June, 1982.

8. Opposers own the domain name opuscorp.com.

9. Commencing long prior to the filing date of Applicant's Application, Opposers have prominently used, and is now using, Opposer's Registered OPUS Marks. Opposers have extensively advertised, promoted and offered Opposer's services under the Registered OPUS Marks to the public through various channels of trade and commerce with the result that Opposer's customers and the public in general have come to know and recognize Opposers' Registered OPUS Marks and associate the same with Opposers and services offered by Opposers. Opposers' Registered OPUS Marks have thus attained significant good will and Opposers have acquired substantial common law rights in the mark OPUS and the trade name OPUS.

10. Upon information and belief, Opposers allege that any use of the alleged OPUSTONE mark by Applicant occurred long after Opposers' adoption and continuous use and

registration of Opposers' OPUS Word Mark. Applicant, therefore, knew or should have known of Opposers' OPUS Word Mark.

11. Applicant's proposed mark is substantially similar to Opposers' Registered OPUS Marks. Specifically, Applicant's proposed mark is identical to Opposers' OPUS Word Mark with the mere addition of the descriptive word, TERRA. Likewise, Applicant's proposed mark is identical to the word component of Opposers' OPUS Design Mark with the mere addition of the descriptive word, TERRA.

12. The goods and/or services that are recited in the Application are all related to construction. The same or similar goods and/or services are provided by Opposers.

13. The goods and/or services that are recited in the Application are related to the goods and/or services recited in the Registered OPUS Marks.

14. Applicant's proposed mark is likely to be confused with Opposers' Registered OPUS Marks because the word marks are substantially identical and the services are the same, similar or related.

15. Applicant's proposed mark is likely to be confused with Opposers' common law service mark and trademark rights in the mark OPUS for real estate development, architecture and engineering, construction, property management, financing, leasing and sales services.

16. Applicant's proposed mark is likely to be confused with Opposers in that the proposed mark is substantially identical to Opposers' trade name, the use of which in the United States occurred long before the filing date of the Application or the alleged first use date in the Application.

17. Opposers, upon information and belief, aver that its customers and the public in general are likely to be confused, mistaken or deceived as to the origin and sponsorship of

Applicant's goods and/or services rendered under Applicant's mark, and misled into believing that such goods and/or services are rendered by, emanate from or are in some way directly or indirectly associated with Opposers, to the damage and detriment of Opposers and their reputation.

18. According rights of federal registration to the mark that is the subject of the Application is inimical to the superior rights of the Opposers to use the mark in connection with the same, similar or related services.

Dated: March 21, 2007

BRIGGS AND MORGAN, P.A.

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